

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-19 were pending in this application when last examined.

Claims 1-10, 12 and 18 were examined on the merits and stand rejected.

Claims 11, 13-17 and 19 were withdrawn as non-elected subject matter.

Claim 1 is amended to incorporate the subject matter of claim 8. Further, claim 1 is amended to define the synthesized cDNA as “possessing a 5'-end nucleotide of (dT)_ndG, wherein n=0-5” and to define that the first-strand cDNA possesses a 3'-end “dC(dA)_n, where n=0-5”. Support for this amendment can be found on page 8, line 30 to page 9, line 7, and on page 10, lines 16-23, of the specification as filed.

The other claims have been amended to conform with the changes to claim 1 and the cancellation of claim 8 or to correct informalities.

Claims 8, 12 and 18 are canceled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any canceled subject matter.

Thus, no new matter has been added.

II. CLAIM OBJECTIONS

On page 2 of the Office Action, claims 12 and 18 were objected to. These claims are canceled and therefore this objection is moot.

III. UTILITY REJECTION

On page 2 of the Office Action, claims 12 and 18 were also rejected under 35 U.S.C. § 101. These claims are canceled and therefore this rejection is moot.

IV. INDEFINITENESS REJECTION

In item 4 of page 3 of the Office Action, claims 1-10, 12 and 18 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants respectfully traverse this rejection, as applied to the remaining amended claims, for the following reasons.

Claim 1, the only remaining independent claim under examination, is amended to clarify the claimed method. In particular, the “cap” has been more particularly defined and its relationship to the components of the claimed methods has been clarified. Furthermore, the term “conjugate” has been removed.

In regard to claims 12 and 18, these claims are canceled and therefore this part of this rejection is moot.

Thus, Applicants respectfully suggest that this rejection, as applied to the remaining amended claims, is untenable and should be withdrawn.

V. ANTICIPATION/OBVIOUSNESS REJECTIONS

In item 5, on pages 4-6 of the Office Action, claims 1, 3-8, 10, 12 and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by Chenchik et al. (U.S. Patent No. 5,962,271). In item 7 on pages 6-7 of the Office Action, claims 2 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chenchik et al. as applied above in view of Chenchik et al. (U.S. Patent No. 6,352,829).

These rejections are addressed together. Applicants respectfully traverse these rejections, as applied to the amended claims, for the following reasons.

Applicants note that claim 1, the only remaining independent pending claim, is directed toward a method for synthesizing cDNA possessing a 5'-end nucleotide of (dT)_ndG, wherein n=0-5), comprising the steps of

- (i) annealing a double-stranded DNA primer and an mRNA mixture,
- (ii) preparing an mRNA/cDNA heteroduplex by synthesizing the first-strand cDNA primed with the double-stranded DNA primer using reverse transcriptase, wherein the 3'-end nucleotide of the first-strand cDNA is dC(dA)_n, wherein

n=0-5,

- (iii) circularizing the mRNA/cDNA heteroduplex by joining the 3' and 5' ends of the DNA strand containing the first strand cDNA using ligase, and
- (iv) replacing the RNA in the mRNA/cDNA heteroduplex with the second-strand cDNA thereby synthesizing the cDNA possessing the 5'-end nucleotide of (dT)_ndG, wherein n=0-5.

In particular, Applicants note that claim 1 has been amended to specify the second strand cDNA possesses a 5'-end nucleotide of (dT)_ndG, wherein n=0-5. Applicants further note that the '271 patent fails to teach or suggest this structure. Applicants also note this is the primary references of both the anticipation and obviousness rejections. Thus, Applicants submit that the cited art fails to teach or suggest each and every element of the claimed invention as required under U.S. law. Thus, Applicants submit that these rejections, as applied to the remaining amended claims, are untenable and should be withdrawn.

VI. CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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